

### **REMARKS/ARGUMENTS**

Entry of this amendment and reconsideration of the present application, as amended, are respectfully requested.

Claims 1-11 and new claims 47-81 are presently active in this application, claims 12-46 having been cancelled. Claims 1-11 are amended. Unless an argument is made below to distinguish a claimed embodiment over the cited prior art based on a particular change to the claim, the changes to the claims do not relate to patentability.

#### **Election/Restrictions**

Claims 12-46, withdrawn from consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to non-elected inventions, have been cancelled without prejudice to filing a divisional application directed to the subject matter of these claims.

#### **Claim Rejections-35 U.S.C. §103**

Claims 1, 2 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Eld (U.S. Pat. No. 5,545,141) in view of Klingenstein (U.S. Pat. No. 6,149,581). Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Eld and Klingenstein in view of Amplatz et al. (U.S. Pat. No. 4,991,602) and Scribner et al. (U.S. Pat. No. 5,830,125). Claims 4, 5, 9 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Eld and Klingenstein in view of Gill (U.S. Pat. No. 5,851,195). Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Eld and Klingenstein in view of Cragg (U.S. Pat. No. 6,315,789). Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Eld and Klingenstein in view of Cosmetto et al. (U.S. Pat. No. 5,127,412).

The Examiner's rejections are respectfully traversed.

Claim 1 has been amended to clarify the invention and now recites a method for inserting an apparatus into a bowel including inserting a guidewire into the bowel through an opening into the bowel, then passing a filament, unattached to the guide wire, from outside the bowel through

the bowel wall into the bowel lumen and into initial engagement with the guidewire at a location in the bowel, withdrawing the guidewire from the bowel and out of the opening, after the filament is engaged with the guidewire, to thereby draw the filament through the bowel and out of the opening, attaching the apparatus to the filament after the guidewire and engaged filament have been withdrawn from the bowel, and drawing the filament with attached apparatus back through the opening into the bowel.

The prior art cited by the Examiner does not disclose, teach or suggest features set forth in claim 1. For example, the cited prior art does not disclose the particular claimed technique for attaching a filament to a guidewire (or more generally a probe) which is situated in a bowel to enable the filament to be drawn through the bowel upon withdrawal of the guidewire from the bowel. In embodiments of the present invention, this technique includes inserting a guidewire into a bowel, then passing a filament unattached to the guidewire, from outside the bowel through the bowel wall into the bowel lumen and into initial engagement with the guidewire. Thus, the filament is first engaged with the guidewire in the bowel. Withdrawal of the guidewire from the bowel and out of the opening, after the filament is engaged with the guidewire, causes the filament to be drawn through the bowel and out of the opening and can be subsequently used to draw the apparatus back into the bowel.

Eld describes a fundamentally different technique for attaching a filament to a probe situated in the bowel. In Eld, a gastronomy device having a removable needle (the probe) is inserted into the bowel and then a needle of the device is unshielded and actuated to pierce the bowel wall from the inside and extended to a location outside of the body. The filament is then attached to the needle outside of the body, and thus outside of the bowel, and then the needle is drawn back into the bowel with the attached filament.

Accordingly, the location at which the filament is attached to the probe in Eld (outside of the bowel) is significantly different than the location at which the filament is attached to the probe in the invention (inside the bowel). Eld therefore does not teach the step of passing a filament, unattached to a guidewire, from outside the bowel through the bowel wall into the

bowel lumen and into initial engagement with the guidewire at a location in the bowel as set forth in claim 1. Indeed, the probe of Eld is intentionally constructed to enable filament to be attached to the probe at a location outside of the bowel. Therefore, Eld cannot even remotely suggest attaching filament to a probe inside the bowel.

There are several advantages of attaching the filament to a probe (guidewire) inside the bowel instead of outside the bowel. For example, since the probe does not leave the bowel, the construction of the probe can be optimized to pass through the long and tortuous bowel and thus can be provided with a bulbous tip to enable it to be more easily manipulated through the bowel. Further, the construction of the probe can be simplified and thus its cost kept low since it does not require any actuating mechanism, e.g., of the type disclosed in Eld to actuate the needle.

Klingenstein, Amplatz et al., Scribner et al., Gill, Cragg and Cosmetto also do not disclose the technique for attaching a filament to a probe as set forth in claim 1.

Since the cited prior art does not disclose all of the features set forth in claim 1, the cited prior art cannot be combined to render obvious the embodiment of the invention set forth in claim 1, or in claims 2-5 and 7-11 which depend directly or indirectly from claim 1.

In view of the foregoing, it is respectfully submitted that the Examiner's rejections of claims 1-5 and 7-11 have been overcome and should be removed and that the present application is now in condition for allowance.

#### Allowable Subject Matter

Claim 6 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

New claim 58 is presented which includes subject matter from original claims 1 and 6. In view of the Examiner's indication of allowable subject matter in claim 6, it is respectfully submitted that claim 58 should be allowable over the prior art of record.

### New Claims

Claims 47-81 are presented. In view of the cancellation of claims 12-46, no additional fee is due for the presentation of these claims. However, if any fee is deemed to be due, it should be charged to Deposit Account No. 50-1268.

Claims 47-57 depend directly or indirectly from claim 1 and are drawn to the elected invention.

Claim 58 is discussed above and is also drawn to the elected invention.

Claim 59 is a new independent claim which recites the technique for attaching filament to the guidewire in a slightly different manner than set forth in claim 1. Whereas claim 1 recites the step of "passing the filament, unattached to the guidewire, from outside the bowel through the bowel wall into the bowel lumen and into initial engagement with the guidewire at a location in the bowel", claim 59 recites the step of "without the forward end of the guidewire exiting the bowel, passing a filament through the bowel wall into the bowel lumen and then bringing the filament and forward end of the guidewire into engagement with one another at the second location in the bowel".

Claims 60-79 depend directly or indirectly upon claim 59.

Claim 80 is a new independent claim which recites the technique for attaching filament to the guidewire in a slightly different manner than set forth in claim 1. Whereas claim 1 recites the step of "passing the filament, unattached to the guidewire, from outside the bowel through the bowel wall into the bowel lumen and into initial engagement with the guidewire at a location in the bowel", claim 80 recites the steps of "engaging filament to a needle outside of the bowel prior to formation of a passage for or by the needle through the bowel wall; then passing the needle with engaged filament from outside the bowel through the bowel wall into the bowel lumen and into engagement with the guidewire at a location in the bowel."

Claim 81 depends upon claim 80.

For the same reasons that claim 1 should be patentable over the cited prior art, claims 59-81 should also be patentable over the cited prior art.

Further, claims 59-81 are all drawn to the elected invention, a method for inserting an apparatus into a bowel and thus should be considered together with claims 1-11 in this application.

An early and favorable action on the merits upon entry and consideration of this amendment is earnestly solicited.

FOR THE APPLICANT  
Respectfully submitted,

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